

REMARKS/ARGUMENTS

In the Office Action, the Examiner rejected claims 1-3, 8-11, 13-31, 35-41 and 43-65. By the present Response, Applicants have amended claims 1-3, 17, 18, 31 and 63. These amendments do not add any new matter. Upon entry of these amendments, claims 1-3, 8-11, 13-31, 35-41 and 43-65 will remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Objection to the Specification

In the Office Action, the Examiner objected to the abstract “because of the use of the phrase ‘are disclosed herein’ is improper.” Office Action, page 2. Applicants have amended the abstract in accordance with the Examiner’s suggestions and request withdrawal of the objection to the specification.

Claim Objections

In the Office Action, the Examiner objected to claims 3, 11, 14, 18, 27, 31, 41 and 44. Specifically, the Examiner stated:

Claim 3 is objected to because of the following informalities: The word “or” in line 3 must be changed to --and--. Appropriate correction is required.

Claim 11 is objected to because of the following informalities: The use of the phrase “step (a)” is improper. Examiner suggests that “step (a)” be changed to --the step of forming at least a portion of a well bore--. Appropriate correction is required.

Claims 14, 27, and 44 are objected to because of the following informalities: These claims are still improperly constructed claims because of the recitation of “and mixtures thereof” or “and combinations thereof.” These recitations should be deleted. Appropriate correction is required.

Claim 18 is objected to because of the following informalities: Claim 18 positively recites limitations which were already recited in claim 1. Appropriate correction is required.

Claim 31 is objected to because of the following informalities: In line 1, "a section" should be changed to --multiple sections-- in order to be consistent with the rest of claim 31 and its dependent claims. Appropriate correction is required.

Claim 41 is objected to because of the following informalities: The use of the phrase "step (b)" is improper. Examiner suggests that "step (b)" be changed to --the step of drilling at least a portion of the well bore--. Appropriate correction is required.

Office Action, pages 2-3.

Regarding the Examiner's objection to claim 3, Applicants have amended claim 3 in accordance with the Examiner's suggestion to further prosecution. Specifically, Applicants replaced the term "or" with the term "and." In view of this amendment, Applicants request that the Examiner withdraw the objection to claim 3.

Applicants respectfully traverse the Examiner's objections to claims 11 and 41. First, the Examiner has provided no support for the assertion that the use of phrases such as "step (a)" and "step (b)" are improper. Second, Applicants assert that claims employing such terms have long been accepted by the U.S.P.T.O. For example, claims 15-19 of Coats et al. (U.S. Patent No. 6,435,447) are representative of claims of a similar nature that were allowed by the U.S.P.T.O. Further, the seventh edition of the M.P.E.P. actually utilizes claims of a similar form as examples. *See* M.P.E.P. § 2106 (7th ed. 1998). In view of the clear precedent established by these references, among others, Applicants stress that the uses of the terms "step (a)" and "step (b)" in claims 11 and 41, respectively, are proper. Accordingly, Applicants request that the Examiner withdraw the objection to claims 11 and 41.

Applicants respectfully traverse the Examiner's objection to claims 14, 27 and 44. As set forth above, the Examiner asserted that these claims are improperly constructed because they recite "and mixtures thereof" or "and combinations thereof." *See* Office Action, page 3. However, Applicants stress that the Examiner has provided no support for this assertion. Further, Applicants respectfully remind the Examiner that this type of claim language is

endorsed by the Federal Circuit. Indeed, in *Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, the Federal Circuit stated the following:

If a patentee desires mixtures or combinations of the members of a Markush group, the patentee would need to add qualifying language while drafting the claim. *See Meeting Held to Promote Uniform Practice In Chemical Divisions, supra*, at 852 (citing examples of qualifying language such as: “and mixtures thereof” and “at least one member of the group”).

67 U.S.P.Q.2d 1191, 1196 (Fed. Cir. 2003). In view of this clear precedent set forth by the Federal Circuit, Applicants assert that the language utilized in claims 14, 27 and 44 is proper. Accordingly, Applicants request that the Examiner withdraw the objection to claims 14, 27 and 44.

Applicants presently amend claim 18 to address the antecedent basis issues pointed out by the Examiner. Specifically, Applicants presently amend claim 18 to clearly modify the recitation of “jetting a stimulation fluid through at least one port” of claim 1 such that “the fluid is jetted through the fluid jet forming nozzle.” Accordingly, Applicants request that the Examiner withdraw the objection to claim 18.

Regarding claim 31, while Applicants do not agree with the Examiner’s objection, Applicants presently amend claim 31 to further prosecution. Specifically, Applicants presently amend claim 31 to remove the limitations that Applicants believe are causing confusion as to the scope of the claim. In view of the present amendment, Applicants request that the Examiner withdraw the objection to claim 31.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 8-11, 14, 16-25, 31, 35-41, 44-54 and 57-65 under 35 U.S.C. § 102(b) as being anticipated by Whiteley (U.S. Patent No. 6,006,838, hereafter referred to as “the Whiteley reference”). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Rejection of Independent Claim 1

In the present application, independent claim 1 has been amended to recite the following step:

[S]timulating a section of the subterranean formation using a stimulation tool interconnected with a drill string located in the portion of the well bore and used in the drilling operation, *wherein the stimulating is initiated without removal of the drill string from the portion of the well bore after using the drill string to form the portion of the well bore*, the stimulating comprising jetting a stimulation fluid through at least one port in the stimulation tool against the section of the subterranean formation at a pressure sufficient to create at least one cavity in the section of the subterranean formation.

(Emphasis added).

Applicants respectfully submit that the Whiteley reference does not disclose “stimulating a section of the subterranean formation ... *without removal of the drill string* from the portion of the well bore *after using the drill string to form the well bore*,” as recited in claim 1. (Emphasis added). While the Whiteley reference teaches that an assembly including multiple stimulation modules may be *repositioned* without tripping the assembly out of the well bore, it does not teach that the same assembly used to *drill* the well bore is utilized for stimulation *without tripping the assembly out of the well bore*. *See Whiteley et al.*, col. 3, lines 22-25. Indeed, based on the teachings of the Whiteley reference, it appears that after the well bore is formed, the tailpipe string would have to be removed to install the modules 5, 10, 15 and 20 for stimulating the production zones. *See id.* Fig. 1. This is clear because the Whiteley reference does not teach

that the assembly including the stimulation modules 5, 10, 15 and 20 also includes a drill bit. For example, FIG. 1 of the Whiteley reference clearly illustrates that a drill bit is *not* attached. *See id.* FIG. 1. Without a drill bit, it would not be possible to initiate stimulation “without removal of the drill string from the portion of the well bore after using the drill string to form the portion of the well bore,” as recited in claim 1. Further, while the Whiteley reference teaches that stimulation modules 5, 10, 15 and 20 may be attached to a tailpipe string comprising “drillpipe,” there is no indication in the Whiteley reference that the tailpipe string includes a drill bit. *See id.* col. 3, lines 7-25; FIG. 1. In other words, the mere statement that the tailpipe string may comprise drillpipe does not mean that the assembly of the Whiteley reference was utilized to drill the well bore. Rather, as set forth above, the tailpipe string would have been removed to detach any drill bit that may have been present and attach the modules 5, 10, 15 and 20 to form the assembly described by the Whiteley reference. Accordingly, Applicants stress that the Whiteley reference fails to anticipate claim 1 and the claims depending therefrom because it fails to teach “stimulating a section of the subterranean formation ... *without removal of the drill string* from the portion of the well bore *after using the drill string to form the well bore*,” as recited in claim 1. (Emphasis added).

Rejection of Independent Claim 31 and 57

In the present application, independent claims 31 and 57 each recite the following step:

[P]roviding a drill string that comprises a stimulation tool interconnected as a part of the drill string *and a drill bit attached at an end of the drill string*.

(Emphasis added).

As indicated above, Applicants respectfully submit that the Whiteley reference does not disclose “a drill string that comprises a stimulation tool ... *and a drill bit*,” as recited in claims 31 and 57. (Emphasis added). Indeed, FIG. 1 of the Whiteley reference clearly illustrates that a drill bit is *not* attached. *See Whiteley et al.*, FIG. 1. This is a clear deficiency in the Whiteley reference. Accordingly, Applicants stress that the Whiteley reference fails to anticipate claims 31 and 57 and the claims depending therefrom because it fails to teach “a drill string that

comprises a stimulation tool ... *and a drill bit*,” as recited in claims 31 and 57. (Emphasis added).

Further, not only is the cited reference deficient, the Examiner did not even address all of the recited features of independent claims 31 and 57 in the Office Action. Rather, it appears that the Examiner merely grouped independent claims 31 and 57 into the rejection of independent claim 1. Applicants respectfully remind the Examiner that “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” M.P.E.P. § 707.07(d). Accordingly, if the Examiner chooses to maintain a rejection in any future Office Action, Applicants respectfully request that the Examiner consider all of the recited features in each of the claims.

For the foregoing reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and allowance of independent claims 1, 31 and 57, and the claims depending therefrom.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 13, 15 and 43 under 35 U.S.C. § 103(a) as being unpatentable over the Whiteley reference; rejected claims 26, 27, 30, 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over the Whiteley reference in view of Soliman (U.S. Patent No. 5,111,881, hereafter referred to as “the Soliman reference”); and rejected claims 26-29, 55, and 56 under 35 U.S.C. § 103(a) as being unpatentable over the Whiteley reference in view of Guinn (U.S. Re. 27,459, hereafter referred to as “the Guinn reference”). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish a *prima facie* case of obviousness, the Examiner must show, among other things, that the combination includes *all* of the claimed elements. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Rejection of Dependent Claims

Applicants note that all of the claims rejected under 35 U.S.C. § 103 are each dependent (directly or indirectly) on either independent claim 1 or independent claim 31. Thus, each of the claims rejected under 35 U.S.C. § 103 depends from a claim rejected under 35 U.S.C. § 102, based on the Whiteley reference. As discussed above, the Whiteley reference does not disclose each and every feature recited in independent claims 1 and 31. Further, the Examiner's assertions regarding the Soliman and Guinn references do not remedy the deficiencies of the Whiteley reference. As such, none of the cited references whether considered alone or in a hypothetical combination are believed to render the presently pending claims obvious. Accordingly, in view of the arguments set forth above, Applicants respectfully request that the Examiner withdraw each of the rejection under 35 U.S.C. § 103 and provide an indication of allowance for claims 13, 15, 26-30, 43, 55 and 56.

Payment of Fees and Authorization for Extensions of Time

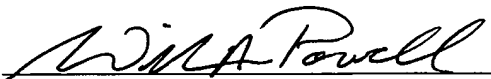
Applicants do not believe that any fees are due. However, if any fees, including fees for extensions of time and other reasons, are deemed necessary to advance prosecution of the present application, at this or any other time, Applicants hereby authorize the Commissioner to charge such requisite fees to Deposit Account No. 06-1315; Order No. HLBT:0021. In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof.

Conclusion

Applicants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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